

**Remarks**

Claims 1-4, 6, 12-14 and 24 were rejected under 35 U.S.C. § 103(a) based upon Fima, US Patent No. 4,250,650 in view of Treon, US Patent No. 4,799,327, Garr, US Patent No. 4,727,674, and Bomann, US Patent No. 6,393,757.

The Examiner has taken various elements that are found in the preceding four patents and indicated that it would have been obvious to a person of ordinary skill in the art to combine the references to produce the invention defined in independent claims 1 and 24.

Submitted herewith is a Declaration of Eric Aanenson, one of the name inventors in this patent application. This Declaration provides numerous details on how the claimed deep sea fishing lure offers superior performance when compared to other lures, which supports that position that the claimed deep sea fishing lure is non-obvious when viewed in light of the cited references.

Deep sea fishing is quite different than other types of fishing such as is done in lakes or rivers because the fish are generally significantly larger than the fish found in lakes and rivers. Aanenson Decl at ¶ 5. As the name deep sea fishing implies, the fish that are desired to be caught when doing deep sea fishing are generally located much further beneath the water surface than fishing done on lakes or rivers. Aanenson Decl. at ¶ 6.

Because of the typical size of fish such as blue fin tuna, yellow fin tuna and swordfish that are caught during deep sea fishing and the difficulty of catching such fish, there is a relatively large value placed on these fish. Aanenson Decl. at ¶ 7. The relatively large value of these fish encourages many persons to go on fishing excursions attempting to catch such fish even though it is quite challenging to catch such fish. Aanenson Decl. at ¶ 8. Accordingly, there is significant demand for fishing lures that will enhance the ability to catch fish while deep sea fishing. Aanenson Decl. at ¶ 9.

The difficulty in studying deep sea fishing is also complicated by the fact that the areas in which desirable deep sea fish such as blue fin tuna, yellow fin tuna and swordfish are located are often a significant distance from ports at which the fishing boats originate. Aanenson Decl. at ¶ 10. For example, it is not uncommon for a deep sea fishing boat to

travel more than 10 hours prior to reaching the area where it is desired to conduct the deep sea fishing. Id.

It is also not uncommon for deep sea fishing excursions to last many days or weeks. Aanenson Decl. at ¶ 11. It is commonly accepted that most of the time on such excursions is spent searching for areas in which the deep sea fish are located rather than repeatedly reeling in fish that have been caught. Id.

Another complicating factor associated with deep sea fishing is that it is much more difficult to study the interaction between fish that are desired to be caught and the lures that are used to catch such fish when compared to fishing that is done at much shallower depths in lakes or rivers. Aanenson Decl. at ¶ 12.

The deep sea fishing lure used in conjunction with the tests set forth below includes a lure body, a first linear bank of display lights, a circular bank of display lights, a fiber optic bundle, a battery pack and an on/off switch. Aanenson Decl. at ¶ 13. The lure body includes a housing with sidewalls made of a generally light-transmissive material and an interior space for accommodation of display lights. Id. The first linear bank of display lights is installed in the housing parallel to an intended direction of travel of the lure through a body of water and includes a plurality of spaced apart individual electric light sources viewable through the light-transmissive material sidewalls of the housing. Id. The circular bank of display lights is installed in the housing aft of the first linear bank of lights and includes a plurality of spaced apart, aft facing individual electric light sources. Id. The fiber optic bundle has a first end connected inside the housing next to the circular light bank so as to receive light from the circular light bank, and a second end extending aft out of the housing to transmit light from the circular light bank. Id. The battery pack is installed in the housing and is connected to the light sources. Id. The on/off switch is connected between the display light sources and the battery pack to turn the display lights on and off. Id.

Attached to the Aanenson Declaration as Exhibit A is a photo of a deep sea fishing lure referenced in the preceding paragraph with the removable, interchangeable jacket not placed thereon to facilitate better viewing the structure of the deep sea fishing lure. Aanenson Decl. at ¶ 14.

In one fishing excursion where the performance of the deep sea fishing lure claimed in this patent application was evaluated, a boat was fishing using one of the claimed deep sea fishing lures off the coast of New Zealand in 2004. Aanenson Decl. at ¶ 15. During a fishing excursion, which lasted about 33 hours from leaving port until returning to port, three swordfish were caught. Aanenson Decl. at ¶ 16. The three swordfish weighed between 220 pounds and 440 pounds. Id.

Attached to the Aanenson Declaration as Exhibit B is a photo of several persons from the fishing boat posing with two of the three swordfish caught during the excursion referenced in the preceding paragraph. Aanenson Decl. at ¶ 17. For comparison, during the preceding year there were 13 swordfish caught in the same waters off the coast of New Zealand. Aanenson Decl. at ¶ 18.

The remarkable nature on the performance of the deep sea fishing lure of the claimed invention is evidenced by the fact that members of the media were on hand when the boat returned to port to conduct interviews and report on the success of this fishing excursion in catching three swordfish during a period of about 33 hours. Aanenson Decl. at ¶ 19.

On another fishing excursion during August of 2007 off the coast of New Zealand, a blue fin tuna weighing about 550 pounds was caught using the deep sea fishing lure claimed in this patent application. Aanenson Decl. at ¶ 20. Attached to the Aanenson Declaration as Exhibits C and D are two photos of the blue fin tuna referenced in the preceding paragraph. Aanenson Decl. at ¶ 21.

In a fishing tournament held on July 6, 2008, originating from Lahaina, Hawaii, a yellow fin ahi tuna weighing approximately 180 pounds was caught using the deep sea fishing claimed in this patent application. Aanenson Decl. at ¶ 22. Attached to the Aanenson Declaration as Exhibit E is a photo of the yellow fin ahi tuna referenced in the preceding paragraph. Aanenson Decl. at ¶ 23.

As evidence of the superior performance of the claimed deep sea fishing lure, there were 66 boats participating in the Lahaina fishing tournament. Aanenson Decl. at ¶ 24. Of these boats, only four boats caught any fish. Id. While the yellow fin ahi tuna, set forth in Exhibit E of the Aanenson Declaration was the largest fish caught in this tournament, the boat catching this fish was disqualified because of a tournament rule

violation relating to a person other than the fisherman who was attempting to land the yellow fin ahi tuna touching the line. Id.

Further support for the superior performance exhibited by the deep sea fishing lure of the claimed invention is exhibited by the fact that during one of the fishing excursions in which the performance of the fishing lure was being evaluated that is referenced above in Paragraphs 20 and 21, the boat on which the claimed deep sea fishing lure was being used was contacted by a Russian fishing trawler that was operating in the same area and offered \$100,000 for the deep sea fishing lure and the approximately 2,000 pounds of fish that had been caught during the trip. Aanenson Decl. at ¶ 25.

While there is some value that is placed on the fish, a significant portion of the amount offered was attributed to the claimed deep sea fishing lure. Id. Attached to the Aanenson Declaration as Exhibit F is a photo of the Russian fishing trawler referenced in the preceding paragraph. Aanenson Decl. at ¶ 26. The persons on the Russian fishing trawler had expressed frustration at their poor performance when compared to the success of the boat that was using the claimed deep sea fishing lure. Aanenson Decl. at ¶ 27.

In view of the preceding results, it is Declarant's opinion that the combination of elements in the deep sea fishing lure produced according to the invention claimed in the current patent application provides the deep sea fishing lure with performance that is superior to the performance of other fishing lures that do not include all of the claimed elements. Aanenson Decl. at ¶ 28.

The information set forth in this Declaration supports the fact that the claimed deep sea fishing lure is non-obvious when viewed in light of the combination of references that the Examiner has cited as the basis for rejecting the claims that are currently pending in my patent application. Aanenson Decl. at ¶ 29.

In view of the preceding comments, it is submitted that claims 1 and 24 are non-obvious when viewed in light of the cited references. Claims 2-4, 6 and 12-14 depend from independent claim 1 and, as such, are also non-obvious when viewed in light of the cited references. Reconsideration and withdrawal of the rejection of claims 1-4, 6, 12-14 and 24 are respectfully request.

Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable when viewed in light of Fima, Treon, Garr, Bomann and Liebert. Liebert was cited for disclosing a clear epoxy resin filling the interior space of the housing.

Liebert does not overcome the deficiencies discussed above with respect to the rejection of independent claim 1. As such, the addition of Liebert to Fima, Treon, Garr and Bomann does not render claim 8 obvious for the reasons set forth above. Reconsideration and withdrawal of the rejection of claim 8 are respectfully requested.

Claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable when viewed in light of Fima, Treon, Garr, Bomann and Malphrus. Malphrus was cited for disclosing a jacket configured in the likeness of a squid.

Malphrus does not overcome the deficiencies discussed above with respect to the rejection of independent claim 1. As such, the addition of Malphrus to Fima, Treon, Garr and Bomann does not render claim 10 obvious for the reasons set forth above. Reconsideration and withdrawal of the rejection of claim 10 are respectfully requested.

Claim 11 was rejected under 35 U.S.C. § 103(a) as being unpatentable when viewed in light of Fima, Treon, Garr, Bomann and West. West was cited for disclosing a battery pack including a plurality of rechargeable batteries.

West does not overcome the deficiencies discussed above with respect to the rejection of independent claim 1. As such, the addition of West to Fima, Treon, Garr and Bomann does not render claim 11 obvious for the reasons set forth above. Reconsideration and withdrawal of the rejection of claim 11 are respectfully requested.

Claims 15, 18 and 19 were rejected under 35 U.S.C. § 103(a) based upon Fima, Garr and Bomann.

While it is possible to repeat the comments set forth above with respect to the performance of the claimed deep sea fishing lure that are set forth in the Aanenson Declaration, it is believed that such comments would lengthen this already lengthy response. Rather, it is submitted that the preceding comments also apply with respect to the non-obviousness of independent claim 15 because this claim has a similar format to independent claim 1 and the three primary references support this rejection are the same as were used by the Examiner in rejecting independent claim 1.

In view of the preceding comments, it is submitted that claim 15 is non-obvious when viewed in light of the cited references. Claims 18 and 19 depend from independent claim 15 and, as such, are also non-obvious when viewed in light of the cited references. Reconsideration and withdrawal of the rejection of claims 15, 18 and 19 are respectfully request.

Claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable when viewed in light of Fima, Treon, Garr and Liebert. Liebert was cited for disclosing a clear epoxy resin filling the interior space of the housing.

Liebert does not overcome the deficiencies discussed above with respect to the rejection of independent claim 15. As such, the addition of Liebert to Fima, Treon and Garr does not render claim 20 obvious for the reasons set forth above. Reconsideration and withdrawal of the rejection of claim 20 are respectfully requested.

Claim 21 was rejected under 35 U.S.C. § 103(a) as being unpatentable when viewed in light of Fima, Treon, Garr and Malphrus. Malphrus was cited for disclosing a jacket configured in the likeness of a squid.

Malphrus does not overcome the deficiencies discussed above with respect to the rejection of independent claim 15. As such, the addition of Malphrus to Fima, Treon and Garr does not render claim 21 obvious for the reasons set forth above. Reconsideration and withdrawal of the rejection of claim 21 are respectfully requested.

Claim 22 was rejected under 35 U.S.C. § 103(a) as being unpatentable when viewed in light of Fima, Treon, Garr and West. West was cited for disclosing a battery pack including a plurality of rechargeable batteries.

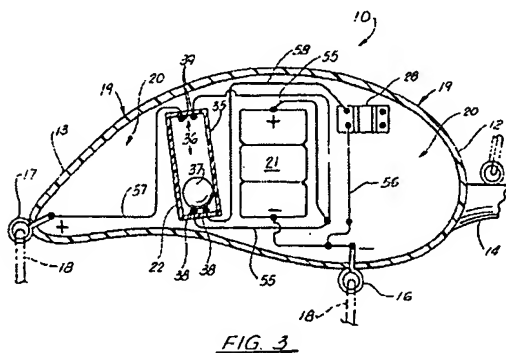
West does not overcome the deficiencies discussed above with respect to the rejection of independent claim 15. As such, the addition of West to Fima, Treon and Garr does not render claim 22 obvious for the reasons set forth above. Reconsideration and withdrawal of the rejection of claim 22 are respectfully requested.

Claims 36-37 and 39 were rejected under 35 U.S.C. § 103(a) based upon Fima in view of King et al., US Patent No. 6,647,659. In support of this rejection, the Examiner contended that Fima disclosed each of the elements of the invention except a rechargeable battery pack that is install in the house and a leader tube that passes

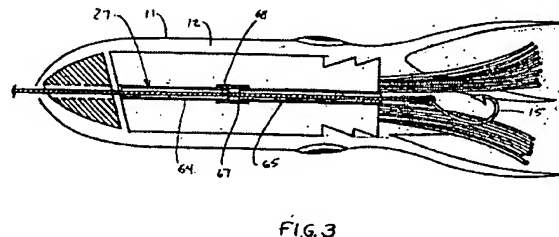
centrally through the body to the battery pack and forms a part of the recharging circuit. The Examiner then cited King for disclosing the preceding elements that were not found in Fima.

While it is believed that claim 36 as previously presented is distinguishable from the cited references because King does not disclose a leader tube, claim 36 has been amended to indicate that a leader wire is extendable through the leader tube.

The Examiner cited Fig. 3 from King as showing the leader tube 35. Reproduced below are Fig. 3 from King and Fig. 3 from the present application to show the difference between the claimed structure and the structure in the cited reference.



King



This Application

As illustrated above and discussed in King, reference numeral 35 identifies a switch housing that is positioned in the center of the King lure. The switch housing 35 has a metal ball bearing 37 slidably mounted therein. When the ball bearing 37 falls to the bottom of the housing 35, the switch is activated.

As is common knowledge in the field of fishing, the leader tube is a tube that extends through a lure. The leader tube is adapted to receive a leader wire, which is connected to a hook 15 that extends out of the aft end of the fishing lure.

Because of the significantly different configuration of the King fishing lure, a fisherman would not perceive reference numeral 35 as identifying a leader tube. Rather, a fore end of the King fishing lure includes an eyelet for attaching to fishing line and an aft end of the King fishing lure includes an eyelet to which a hook is attached.

In view of the preceding comments, it is submitted that Fima and King do not teach or suggest a fishing lure having each of the claimed elements in independent claim

36 or claims 37 and 39 that depend from independent claim 36. Reconsideration and withdrawal of this rejection are respectfully request.

Claim 38 was rejected under 35 U.S.C. § 103(a) as being unpatentable when viewed in light of Fima, King and Ray. Ray was cited for disclosing a magnetically actuated reed switch.

Ray does not overcome the deficiencies discussed above with respect to the rejection of independent claim 36. As such, the addition of Ray to Fima and King does not render claim 38 obvious for the reasons set forth above. Reconsideration and withdrawal of the rejection of claim 38 are respectfully requested.



**Conclusion**

Please enter the amendments above, reconsider the application, and allow all claims. If you have any questions, please contact me at your convenience.

Respectfully submitted,

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